

**REMARKS****Summary of the Office Action**

In the Office Action, claims 1-5, 7-9, and 12-15 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1-3, 6-8, and 12-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,527,269 to *Yamada, et al.*, hereinafter ("*Yamada*").

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,288,062 to *Rizzolo et al.*, hereinafter ("*Rizzolo*").

**Summary of the Response to the Office Action**

Applicant proposes amending claims 1, 6-9, and 12, and canceling claim 2 without prejudice or disclaimer. Accordingly, claims 1-9 and 12-15 are pending for further consideration.

**All Subject Matter Complies with 35 U.S.C. § 112, second paragraph**

Claims 1-5, 7-9, and 12-15 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Independent claims 1, 6, and 12 have been amended to correct the ambiguities pointed out by the Examiner in the August 25, 2005 Office Action. Applicant respectfully submits that this rejection is respectfully traversed in light of the current amendments to claims 1, 6, and 12. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

**All Subject Matter Complies with 35 U.S.C. § 102(e)**

Claims 1-3, 6-8, and 12-14 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Yamada*. Applicant respectfully traverses the rejection for the following reasons.

Applicant respectfully submits that the Office Action has not established that *Yamada* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(e) should be withdrawn. Namely, Applicant contends that newly amended independent claim 1 recites the features of "a pressing member, . . . for holding sheets already collected in said compiling tray and aligned in said sheet alignment portion when a new sheet is supplied to said compiling tray; and a controller that controls said pressing member according to a thickness of sheets collected on said compiling tray." At least these features are not disclosed or taught by *Yamada*.

*Yamada* discloses an apparatus for compiling, jogging, and stapling sheets of paper. See *Yamada* at col. 3, line 15 through col. 4, line 65. However, the structure of *Yamada* fails to teach or suggest at least the above feature of claim 1.

The Office Action states that *Yamada* discloses "a pressing member (including 105, 130)." Contrary to this assertion, *Yamada* discloses a return roller 105 and a return solenoid 13 that act "to move away from the surface of the sheet in a transferring process," and "the sheet is sent downwards by the return roller 105" in a jogging process. See *Yamada* at col. 3, lines 59-61, and col. 4 lines 1-2. *Yamada* actually teaches away from the present invention by disclosing that the so-called pressing member 105 is moved away from the surface of the sheets when a new sheet is supplied. Claim 1 recites that the pressing member must hold "sheets already collected in said compiling tray and aligned in said sheet alignment portion when a new sheet is

supplied to said compiling tray.” Thus, *Yamada* cannot anticipate the invention because it does not hold the sheets when a new sheet is supplied as recited in claim 1. Further, Applicant respectfully submits that the new features “a controller that controls said pressing member according to a thickness of sheets collected on said compiling tray,” recited in claim 1, are also not disclosed by *Yamada*.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Yamada* does not teach or suggest each feature of independent claim 1.

Additionally, Applicant respectfully submits that dependent claims 3-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Applicant respectfully submits that the Office Action does not disclose that *Yamada* anticipates each and every feature of Applicant’s newly amended independent claim 6. Namely, Applicant contends that newly amended independent claim 6 recites the features of “a controller that controls a reference position in a longitudinal alignment in a direction of thickness of sheets stacked on said compiling tray.” At least these features are not disclosed or taught by *Yamada*.

Because *Yamada* does not disclose the above-mentioned features of amended claim 6, it cannot anticipate the invention recited in claim 6. As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987).

Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Yamada* does not teach or suggest each feature of independent claim 6.

Additionally, Applicant respectfully submits that dependent claims 7-9 are also allowable insofar as they recite the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art.

Applicant respectfully submits that *Yamada* fails to anticipate each and every feature of Applicant's newly amended independent claim 12. Namely, Applicant contends that newly amended independent claim 12 recites the features of "said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray." At least these features are not disclosed or taught by *Yamada*.

Because *Yamada* does not disclose the above-mentioned features of amended claim 12, it cannot anticipate the invention recited in claim 12. As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Yamada* does not teach or suggest each feature of independent claim 12.

Additionally, Applicant respectfully submits that dependent claims 13-15 are also allowable insofar as they recite the patentable combinations of features recited in claim 12, as well as reciting additional features that further distinguish over the applied prior art.

**All Subject Matter Complies with 35 U.S.C. § 102(b)**

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Rizzolo*. Applicant respectfully traverses the rejection for the following reasons.

Applicant respectfully submits that the Office Action has not established that *Rizzolo* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicant contends that newly amended independent claim 1 recites the features of "a controller that controls said pressing member according to a thickness of sheets collected on said compiling tray, wherein said pressing member is provided in such a way as to advance and retract between an advancing position, at which said pressing member presses sheets on said compiling tray, and a retreating position at which said pressing member does not hinder the sheets on said compiling tray from being discharged therefrom." At least these features are not disclosed or taught by *Rizzolo*.

*Rizzolo* discloses an apparatus for compiling, jogging, and stapling sheets of paper. See *Rizzolo* at col. 4, line 30 through col. 6, line 48. However, the structure of *Rizzolo* fails to teach or suggest at least the above feature of claim 1.

*Rizzolo* does not disclose the above-mentioned features recited in claim 1. *Rizzolo* actually teaches that the belt 84 can act as a discharge drive mechanism. See col. 5, lines 6-8 of *Rizzolo*. Therefore, the belt 84 cannot move to the retreating position at which the pressing member does not hinder the sheets on the compiling tray from being discharged therefrom. Thus, *Rizzolo* cannot anticipate the invention because it does not have the features recited in claim 1.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the

rejection under 35 U.S.C. § 102(b) should be withdrawn because *Rizzolo* does not teach or suggest each feature of amended independent claim 1.

Additionally, Applicant respectfully submits that dependent claims 3-5 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Applicant respectfully submits that the Office Action has not established that *Rizzolo* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicant contends that newly amended independent claim 6 recites the features of "a controller that controls a reference position in a longitudinal alignment in a direction of thickness of sheets stacked on said compiling tray, for providing a predetermined conveyance force to sheets sequentially supplied to said compiling tray, and for pushing said sheets against said longitudinal reference wall." At least these features are not disclosed or taught by *Rizzolo*.

*Rizzolo* discloses an apparatus for compiling, jogging, and stapling sheets of paper. See *Rizzolo* at col. 4, line 30 through col. 6, line 48. However, the structure of *Rizzolo* fails to teach or suggest at least the above feature of independent claim 6.

*Rizzolo* does not disclose the above-mentioned features. Thus, *Rizzolo* cannot anticipate the invention because it does not teach or suggest all the features recited in claim 6.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the

rejection under 35 U.S.C. § 102(b) should be withdrawn because *Rizzolo* does not teach or suggest each feature of independent claim 6.

Additionally, Applicant respectfully submits that dependent claims 7-9 are also allowable insofar as they recite the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art.

Applicant respectfully submits that the Office Action has not established that *Rizzolo* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicant contends that newly amended independent claim 12 recites the features of "a first moving-aside unit for moving said sheets aside toward said longitudinal reference wall . . . a second moving-aside unit for moving said sheets aside toward said longitudinal reference wall . . . wherein said second moving-aside unit is provided closer to said leading end side than said first moving-aside unit . . . and said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray." At least these features are not disclosed or taught by *Rizzolo*.

*Rizzolo* discloses an apparatus for compiling, jogging, and stapling sheets of paper. See *Rizzolo* at col. 4, line 30 through col. 6, line 48. However, the structure of *Rizzolo* fails to teach or suggest at least the above feature of claim 12.

*Rizzolo* does not disclose a first and second moving-aside unit or the capability of receiving folded sheets on said compiling tray. Thus, *Rizzolo* cannot anticipate the invention because it does not disclose the above-mentioned features recited in claim 12.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Rizzolo* does not teach or suggest each feature of independent claim 12.

Additionally, Applicant respectfully submits that dependent claims 13-15 are also allowable insofar as they recite the patentable combinations of features recited in claim 12, as well as reciting additional features that further distinguish over the applied prior art.



**CONCLUSION**

In view of the foregoing, Applicant respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: December 23, 2005

By: Mary Jane Boswell  
Mary Jane Boswell  
Reg. No. 33,652

**CUSTOMER NO. 009629**  
**MORGAN, LEWIS & BOCKIUS LLP**  
1111 Pennsylvania Avenue, N.W.  
Washington, D.C. 20004  
Tel: 202-739-3000  
Fax: 202-739-3100